REMARKS/ARGUMENTS

In view of the following remarks, the applicant respectfully submits that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicant will now address each of the issues raised in the outstanding Office Action.

Election/Restriction

The Examiner made the earlier restriction requirement final. However, the Examiner did not address the applicant's traversal on the basis of 37 C.F.R. § 1.141(b). As stated in the election:

> [E]ven if the Examiner properly grouped the claims, he did not show that the claims of groups II and III are distinct. Rule 1.141(b) provides that where claims to a product (e.g., a data structure), a process for making, and a process of use are present, a three-way restriction is only proper if the process of making (group III) and the product (group II) are distinct. The Examiner has not alleged that the claims of these groups are distinct. Therefore, the process of using (group

> I) is to be joined with the product and process of making even if the Examiner has shown distinctness between the product and process of using. (See MPEP 806.05(i).)

The applicant reserves its right to petition the restriction under 37 C.F.R. § 1.144.

Rejections under 35 U.S.C. § 102

Claims 1, 6-8, 10-16, 23, 28, 33-35 and 37-43 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,519,591 ("the Guheen patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing various patentable features of the claimed invention, the applicant will first introduce the Guheen patent. The applicant would like to preface the discussion of the Guheen patent by noting it takes a somewhat scattershot approach to discussing the design and development of various Web-based services, as well as to discussing such services, over its 177 sheets of drawings and 288 columns of specification.

The detailed description of the Guheen patent discusses a Web architecture project definition (e.g., required components and those not required) and implementation (e.g., sets of components under each phase of implementation). (See, e.g., column 9, line 26 et seq.) The Guheen patent defines a "framework" as a collection of cooperating classes that make up a reusable design solution for a given problem domain. (See column 31, lines 1-3.)

The Guheen patent then proceeds to detail the use of a development framework in software development. (See, e.g., column 33, line 1 through column 163, line 34.) In particular, the Guheen patent lists various components, each component being provided with implementation considerations and product considerations. In this portion of the Guheen patent, the Examiner cites columns 54 and 55 as teaching an act of searching a searchable data structure. In particular, the Examiner cites column 54, line 66 through column 55, line 3. (The Examiner also cites column 30, lines 55-59 as teaching searching a searchable data structure. The section of column 30 cited merely discusses generic framework code that takes care of almost all event handling and flow control such that less custom program code is needed.) The sections of columns 54 and 55 cited by the Examiner concern searching a "Help Desk" history database, where the help desk provides help to software developers, as a part of service management that provides an interface between an environment management team (which focuses on management tasks such as supporting software developers), software development teams, and external vendors (or service providers).

The Guheen patent then discusses a Web Architecture Framework ("WAF") that may be used to support various features such as e-commerce, content channels, administration, consumer relationship management, content management and publishing, education related services and web customer services. (See, e.g., column 163, line 35-column 288, line 42.) In this portion of the Guheen patent, the Examiner cites:

i) column 238 as teaching an act of accepting a search query;

ii) columns 189 and 207 as teaching the fact that a searchable data structure searched includes advertiser Web information;

iii) columns 192 and 260 as teaching accepting search results;

iv) columns 189, 193 and 194 as teaching an act of retrieving at least one advertisement; and

v) columns 192, 215 and 260 as using at least a portion of accepted search results to retrieve at least one advertisement.

Each of the cited portions of the WAF section of the Guheen patent are introduced, and described in their proper context, below.

The Examiner cites column 238, lines 60-62 as teaching an act of accepting a search query. The cited section of the Guheen patent concerns customer-related Web application services to support a product. In particular, the cited section concerns accepting natural language and/or keyword search queries to support customers that have questions about a product that they have purchased.

The Examiner cites column 189, lines 28-31 and column 207, lines 44 and 45 as teaching the fact that a searchable data structure searched includes advertiser Web information. The cited section of column 189 concerns displaying ads along with items being displayed for purchase. This is part of commerce-related Web application services. (See, e.g., column 172, lines 46-66.) The cited section of column 207 discusses links to Web pages for easy access to published documents in the context of discussion forums and newsgroups.

The Examiner cites column 192, lines 43-45 and column 260, line 6 as teaching accepting search results. The

cited section of column 192 concerns allowing individual users to control the amount of electronic advertising they receive with electronic content since some users will accept receiving such advertisements while other users will be opposed to receiving such advertisements. The cited section of column 260 concerns providing a table of query results in the context of locating channel partners or educational centers.

The Examiner cites column 189, line 28-31, column 193, lines 65-67 and column 194, lines 1-15 as teaching an act of retrieving at least one advertisement. Although the cited section of column 189 does concern displaying advertisements, the cited sections of columns 193 and 194 merely concern allowing customers to order and purchase articles from remote location, and to pickup the purchased articles at stores.

The Examiner cites column 192, lines 43-45, column 215, lines 40-44 and column 260, line 6 as using at least a portion of accepted search results to retrieve at least one advertisement. As already mentioned above, the cited section of column 192 concerns allowing individual users to control the amount of electronic advertising they receive with electronic content since some users will accept receiving such advertisements while other users will be opposed to receiving such advertisements. The cited section of column 215 concerns storing and broadcasting electronic content. Finally, as already mentioned above, the cited section of column 260 concerns providing a table of query results in the context of locating channel partners or educational centers.

Having introduced the Guheen patent, the applicant will now discuss at least some of the patentable features

of the claimed invention. Before doing so, however, since the Examiner's 102-based rejections combine distinct sections of the Guheen patent, the applicant would like to inform (or at least remind) the Examiner of applicable case law. The Court of Appeals for the Federal Circuit ("the CAFC") has instructed that to anticipate, a single prior art reference must "describe all of the elements of the claims, ***arranged as in the [claim]***." (Emphasis added.) C.R. Bard Inc. v. M3 Systems, Inc., 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). This is in accord with previous Court of Claims and Patent Appeals ("the CCPA") decisions. For example, the CCPA has instructed that to anticipate:

> [the] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [claimed invention] ***without any need for picking, choosing and combining various disclosures not directly related to each other*** by the teachings of the cited reference. [Emphasis added.]

In re Arkley, 172 U.S.P.Q. 524, 526 (CCPA 1972).

Claims 1, 6-8, 10-16, 28, 33-35 and 37-43

Independent claims 1 and 28 are not anticipated by the Guheen patent at least because the Guheen patent does not teach an act of (or means for) retrieving at least one advertisement using at least a portion of accepted search results. The Examiner parsed this element into "retrieving at least one advertisement" and "using at least a portion of the accepted search results." In particular, as discussed above, the Examiner cites column 189, line 28-31,

column 193, lines 65-67 and column 194, lines 1-15 as teaching an act of retrieving at least one advertisement. Although the cited section of column 189 does concern displaying advertisements, the cited sections of columns 193 and 194 merely concern allowing customers to order and purchase articles from remote location, and to pickup the purchased articles at stores. The Examiner then cites column 192, lines 43-45, column 215, lines 40-44 and column 260, line 6 as using at least a portion of accepted search results [to retrieve at least one advertisement]. The cited section of column 192 concerns allowing individual users to control the amount of electronic advertising they receive with electronic content since some users will accept receiving such advertisements while other users will be opposed to receiving such advertisements. The applicant respectfully submits that this has nothing to do with using at least a portion of search results to retrieve at least one advertisement. The cited section of column 215 concerns storing and broadcasting electronic content. The applicant respectfully submits that this has nothing to do with using at least a portion of search results to retrieve at least one advertisement. Finally, the cited section of column 260 concerns providing a table of query results in the context of locating channel partners or educational centers. The applicant respectfully submits that this has nothing to do with using at least a portion of search results to retrieve at least one advertisement.

Therefore, independent claims 1 and 28 are not anticipated by the Guheen patent for at least the foregoing reason. Since claims 6-8 and 10-16 depend, either directly or indirectly from claim 1, and since claims 33-35 and

37-43 depend, either directly or indirectly from claim 28, these claims are similarly allowable.

Also, dependent claims 6 and 33 further recite that the searchable data structure (including advertiser Web page information) includes information extracted exclusively from the identified advertiser Web pages. The Examiner again parses this recitation, and contends, in pertinent part, that this feature is described at column 117, lines 22-24 and column 203, lines 26-31 of the Guheen patent. The cited section column 117 of the Guheen patent merely discusses an extraction tool, for allowing software developers to reuse selected portions of a legacy system. The applicant frankly fails to see how this has anything to do with retrieving advertisements, let alone the use of information extracted exclusively from the identified advertiser Web pages (other than the fact that it includes a form of the word "extract" used in an entirely unrelated context). The cited section of column 203 of the Guheen patent merely discusses characteristics properties of fixed income securities such as U.S. treasuries. The applicant frankly fails to see how this has anything to do with retrieving advertisements, let alone the use of information extracted exclusively from the identified advertiser Web pages (other than the fact that it includes a form of the word "exclusive" used in an entirely unrelated context). Accordingly, claims 6 and 33 are not anticipated by the Guheen patent for at least this additional reason.

Also, dependent claims 10 and 37 further recite how the act of (or means for) retrieving at least one advertisement uses Web page identifiers included in the search results. Dependent claims 11 and 38 recite that the Web page identifiers are used as lookup keys to a database

of advertisement information. These features advantageously allow advertisements to be targeted without the need of having advertisers enter targeting information, such as keyword targeting information. (See, e.g., dependent claims 13, 14, 40 and 41.) The Examiner again parses this recitation, and contends, these features are described at various unrelated sections of the Guheen patent. These features are not taught by the cited sections of the Guheen patent. Accordingly, claims 10, 11, 13, 14, 37, 38, 40 and 41 are not anticipated by the Guheen patent for at least this additional reason.

Claim 23

Independent claim 23 is not anticipated by the Guheen patent because the Guheen patent does not teach both a first index including information derived from Web pages of the World Wide Web, and a second index including information derived exclusively from Web pages of advertisers. With regard to the second index, the Examiner cites sections of the Guheen patent that concern media content management, displaying ads with items being displayed for purchase, and links to Webpages in discussion forums and newsgroups. None of these sections teach a second index with the particular features recited in claim 23. Accordingly, claim 23 is not anticipated by the Guheen patent for at least this reason.

Before moving on to address the 103-based rejections, the applicant would like to respectfully, yet emphatically, reiterate a fundamental flaw in the Examiner's 102-based rejections of the claims. That is, the Examiner has parsed the claim elements to such an extent that the context and

relationships in the claimed invention is lost. This parsing does not obviate the Examiner's need to find all of the claimed recitations ***arranged as in the claim***. As stated above, the law clearly prohibits the Examiner's ***picking, choosing and combining various snippets, not directly related to each other*** by the teachings of the Guheen patent. Accordingly, the applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection.

Rejections under 35 U.S.C. § 103

Claims 2-5 and 29-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Guheen patent as applied to claims 1 and 28 above, and further in view of U.S. Patent No. 6,480,843 ("the Li patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Guheen patent does not teach various features of these dependent claims. To compensate for these admitted deficiencies, the Examiner relies on the Li patent. Even assuming, arguendo, that the Li patent includes such teachings and that one of ordinary skill in the art would have been motivated to combine the purported teachings of the Li patent with the Guheen patent as proposed by the Examiner, the proposed combination still would not compensate for the deficiencies of the Guheen patent with respect to claims 1 and 28, discussed above. Accordingly, claims 2-5 and 29-32 are not rendered obvious by the Guheen and Li patents for at least this reason.

Claims 9 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Guheen patent as applied to claims 7 and 34, and further in view of U.S. Patent No. 6,119,101 ("the Peckover patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Guheen patent does not teach scoring, using at least the search result scores and further using at least one of (1) ad performance information, (2) ad price information (3) advertiser quality information, and (4) user information, at least some of the retrieved at least one advertisement. To compensate for this admitted deficiency, the Examiner relies on the Peckover patent. Even assuming, arguendo, that the Peckover patent includes such a teaching and that one of ordinary skill in the art would have been motivated to combine the purported teaching of the Peckover patent with the Guheen patent as proposed by the Examiner, the proposed combination still would not compensate for the deficiencies of the Guheen patent with respect to claims 1 (and 7) and 28 (and 34), discussed above. Accordingly, claims 9 and 36 are not rendered obvious by the Guheen and Peckover patents for at least this reason.

Conclusion

In view of the foregoing remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicant requests that the Examiner pass this application to issue.

Respectfully submitted,

August 8, 2005

John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 542-9070

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **August 8, 2005** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

John C. Pokotylo

36,242
Reg. No.